

product of the heterologous gene. The specification, however, allegedly only provides the following representative species encompassed by the invention: a *Corynebacterium glutamicum* strain transformed with an inactivated *secD* gene consisting of nucleotides 1200-1809 of SEQ ID NO:1; a *Corynebacterium glutamicum* strain transformed with SEQ ID NO:1 which encodes the SecD protein or SEQ ID NO:2 which encodes the SecF protein; and a *Corynebacterium glutamicum* strain transformed with SEQ ID NO:1 which encodes the SecD protein, SEQ ID NO:2 which encodes the SecF protein, and amylase gene.

Claims 1-8 were also rejected under 35 U.S.C. § 112, first paragraph, as allegedly being broader than the enabling disclosure. Specifically, it is the examiner's position that while being enabled for an isolated *Corynebacterium glutamicum* host cell transformed with an inactivated *secD* gene consisting of nucleotides 1200-1809 of SEQ ID NO:1, an isolated *Corynebacterium glutamicum* host cell transformed with a heterologous nucleic acid comprising the nucleotide sequence of SEQ ID NO:1 which encodes the SecD protein or the nucleotide sequence of SEQ ID NO:2 which encodes the SecD protein, and a *Corynebacterium glutamicum* strain transformed with SEQ ID NO:1 which encodes the SecD protein, SEQ ID NO:2 which encodes the SecF protein, and amylase gene; the specification does reasonably provide enablement for any other embodiment.

The applicants respectfully traverse and submit that in view of the foregoing amendment to the claims, the rejections based upon 35 U.S.C. §112, first paragraph is moot. Specifically and solely to expedite prosecution and without prejudice to the applicants' right to seek broader claims in a duly filed continuing application, the applicants have replaced the pending claims with claims that are directed to (*inter alia*) specific *Corynebacterium glutamicum* that contain specific isolated polynucleotides that encode specific polypeptides that retain a specific and identifiable activity.

In view of the foregoing, the applicants submit that the claimed invention does not lack written description and is fully enable by the accompanying specification and therefore request that the rejection based upon 35 U.S.C. §112, first paragraph be withdrawn and not be extended to new claims 20-39.

Claims 1-8 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase “characterized in that genetical modification concerns at least one of the genes *secD* and *secF*” is allegedly vague and indefinite because all the specific genetic modifications are not known and not defined in the specification. Claims 2-8 which depend from claim 1 is also rejected because they do not correct the defect of claim 1.

In claim 2, the phrase “respective homologous sequences” allegedly renders the claim vague and indefinite because the specific nucleotide sequences of the “respective homologous sequences” are not known and defined in the specification and it is not known when nucleotide sequences are or are not “respective homologous sequences.”

Claim 3 is allegedly vague and indefinite because it is not known whether the recited limitations are directed to the *secD* and *secF* genes or to any other genes and it is not known what specific nucleotides are deleted, inserted, mutated, or rearranged.

Claim 8 is allegedly vague and indefinite because the claimed substance which is the “product of the claimed heterologous gene or is produced by this heterologous gene product” is not known and defined in the specification.

The applicants respectfully traverse and submit that in view of the foregoing amendment to the claims, the rejections based upon 35 U.S.C. §112, second paragraph is moot. Specifically claims 20-39 do not contain the language referred to by the examiner.

In view of the foregoing, the applicants submit that the claims defining the present invention are neither vague nor indefinite and therefore request that the rejection based upon 35 U.S.C. §112, second paragraph be withdrawn and not be extended to new claims 20-39.

III. CONCLUSION

In view of the foregoing, the claims are now believed to be in form for allowance, and such action is hereby solicited. If any point remains in issue that the examiner feels may be best resolved through a personal or telephone interview, the examiner is strongly urged to contact the undersigned at the telephone number indicated below.

Respectfully submitted,

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Enclosure: Appendix

APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS

Claims 1-8 are canceled.

Claims 20-39 are added.

End of Appendix